

DOCKET NO.: 290082US0PCT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

GROUP: 1611

Satoshi NAGAI, et al.

SERIAL NO: 10/576,948

EXAMINER: Polansky, Gregg

FILED: January 8, 2007

FOR: ALLERGEN DEPRESSANT AND DEPRESSION METHOD

RESTRICTION RESPONSE

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

Sir:

In response to the Restriction Requirement dated October 1, 2008, Applicants elect, with traverse, Group I, Claims 1-5, for examination. As single disclosed species, Applicants provisionally elect, for examination purposes only, Aculynn22 (Please refer to page 60, lines 1-3, in the specification. Claims 1-5 read on the elected specie.

Remarks/Arguments begin on page 2 of this paper.

REMARKS/ARGUMENTS

The claims have been divided into Groups as follows:

Group I: Claims 1-5, drawn to an allergen-reducing agent comprising water and a disclosed water-soluble polymer compound.

Group II: Claims 6-11, drawn to a disclosed method of reducing allergens comprising application of a disclosed allergen-reducing agent.

In addition, an election of Species as described below is required:

Specie A: A single, fully disclosed structure of an allergen reducing agent according to Formula (1), (2) or (3) is required.

Specie B: An election of 1) spray or 2) impregnated flexible sheet is required.

If Group I is elected, only a Specie A is required. If Group II is elected, a Specie A and Specie B is required.

Applicants elect, with traverse, Group I, Claims 1-5, for examination. As single disclosed species, Applicants provisionally elect, for examination purposes only, Aculynn22. (Please refer to page 60, lines 1-3, in the specification.)

Claims 1-5 read on the elected specie.

Applicants respectfully traverse the Restriction Requirement on the grounds that no adequate reasons and/or examples have been provided to support a conclusion of patentable distinctness between the identified groups.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (MPEP §803). The burden is on the Examiner to provide reasons and/or examples to support any conclusion in regard to patentable distinction (MPEP §803). Moreover, when citing lack of unity of invention in a national stage application, the Examiner has the burden of

explaining why each group lacks unity with each other group specifically describing special technical features in each group (MPEP § 1893.03(d)).

The Office has asserted that Groups I - II do not relate to a single general inventive concept under PCT Rule 13.1 because “the instantly claimed allergen-reducing agent is not “special” because it does not make a contribution over the prior art; . . .” U.S. Patent Pub. 2005/0256082 is cited as showing formula 1 of the claimed invention.

Annex B of the Administrative Instructions under the PCT at (b) Technical Relationship states:

“The expression “special technical features” is defined in Rule 13.2 as meaning those technical features that defines a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any).”

Applicants respectfully submit that the Examiner has not provided any indication that the contents of the claims interpreted in light of the description was considered in making the assertion of a lack of unity and therefore has not met the burden necessary to support the assertion.

Furthermore, 37 C.F.R. § 1.475(b) states in pertinent part:

“An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

(2) A product and a process of use of said product; . . .”

Applicants respectfully submit that the Office has not considered the relationship of the inventions of Groups I-II with respect to 37 C.F.R. § 1.475(b)(2). Claims 1-5 are drawn to an allergen-reducing agent and, Claims 6-11 are drawn to a use of the allergen-reducing agent.

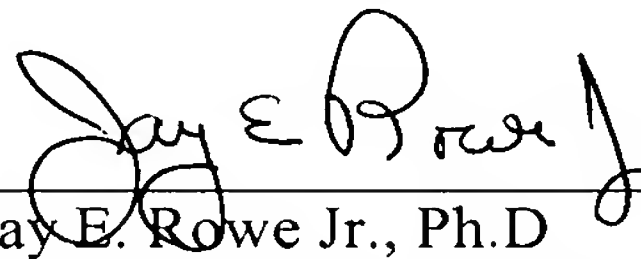
Moreover, Applicants respectfully refer to Annex B of the Administrative Instructions Under the PCT, paragraph (c), which states in part, "Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims." Claims 6-11 all depend directly or indirectly from Claim 1 in this application.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the requirement for restriction. Applicants therefore request that the requirement for restriction be withdrawn.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully Submitted,

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